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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,946	11/13/2003	John Terence Miller	101159-26411	2900
26511	7590	04/14/2005		EXAMINER
HIGGS, FLETCHER & MACK LLP 2600 FIRST NATIONAL BANK BUILDING 401 WEST "A" STREET SAN DIEGO, CA 92101-7910			CEGIELNIK, URSZULA M	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/713,946	MILLER, JOHN TERENCE
Examiner	Art Unit	
Urszula M. Cegielnik	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Office Action Summary

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Amendment filed 23 September 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-8, 10-32, 35-40, 43 and 44 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-8, 10-17, 20, 21, 26, 38-40, 43 and 44 is/are rejected.

7) Claim(s) 18, 19, 22-25, 27-32 and 37 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 10-17, 20, 21, 26, 35, 36, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Lodrick, Sr. (US Patent No. 4,690,657).

Lodrick, Sr. (US Patent No. 4,690,657) discloses an apparatus for playing a game (*such as a pointing device*), the apparatus including a play base (12) and at least a first member (16) located a predetermined spaced distance apart from the play base (12) and movable relative thereto, the movement of at least the result of the movement of the at least first member (16) relating to one or more pre-determined criteria for allowing further playing of the game according to a set of rules, the at least first member (16) is provided with a magnet (16); the magnet (16) interacting with one or more further magnets (32) provided on or associated with the play base (12), a portion (*the portion of the play base 12 being the eccentric 36*) of the play base (12) in or on which the magnets (32) are located is movable relative to a remaining portion of the play base (12); the at least first member (16) is freely and randomly movable relative to the play base (12); the at least first member (16) is suspended above an upper surface of the play base (12) from a frame (14) and the first member (16) is movable relative to the frame (14) and/or the play base (12); the magnet (16) of the first member (16) is

provided with a combination of a pendulum (*such as a pointer which is permitted to swing freely*); the frame (14) is integrally formed with the play base (12) (*the frame is formed integrally with the play base in that it forms a one-piece structure, see Figure 1*); the one or more magnets (32) are provided within the area defined by the frame (14); the at least first member (16) includes an elongate portion (18) is flexible (*i.e. a tether being fiber or string, which is inherently flexible*); the elongate portion (18) is in the form of at least one string or cord; the elongate portion (14) is substantially rigid (*elongate portion 14 is rigid to a certain degree in order to provide support to first member 16 to be suspended above the play base 12*); the one or more magnets (32) of the play base (12) are located under the upper surface (26) of the play base (12); the one or more magnets (32) of the play base (12) are provided in one or more housings or compartments (20) on the play base (12); the movement of the at least first member (16) is determined, at least in part, by the polarities of respective said magnets (32) on the play base (12) and the first member (16); a user initiates movement of the at least first member (16) (*the movement of the at least first member 16 is inherently capable of being moved by the user since it has all of the claimed structure*), whereafter the magnetic interaction of the respective magnets determines any or any combination of the speed, direction and/or degree of further movement of the first member (16) (*the magnetic interaction of the magnet (32) is determined by attractive/repelling forces that influence direction and degree of movement of the first member 16*); one or more predetermined criteria for allowing playing of the game are associated with one or more of the magnets on the play base (12); the portion of the play base (12) on which the

magnets (32) are located is rotatably mounted relative to the remaining portion of the play base (12) (*magnet 32 is rotatably mounted within the eccentric 36*); the portion of the play base (12) on which the magnets (32) are located is provided within the area defined by the frame (14).

Claim 44 is rejected under 35 U.S.C. 102(b) as being anticipated by Conner.

Conner discloses an apparatus for playing a game, the apparatus including a play base (11) and at least a first member (14) located a pre-determined spaced distance apart from the play base (11) and movable relative thereto, the movement or at least the result of the movement of the at least first member (14) relating to one or more pre-determined criteria for allowing further playing of the game according to a set of rules, wherein the at least first member (14) is provided with a magnet (22), the magnet (22) interacting with one or more further magnets (12a-12i) provided on or associated with the play base (11) and wherein the one or more further magnets (12a-12i) are provided at spaced apart intervals on the play base (11), and wherein one or more of the one or more further magnets (12a-12i) have a positive polarity and the remaining one or more further magnets (12a-12i) have negative polarity (col. 3, lines 27-40).

Claims 39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Markham.

Markham discloses a method of using an apparatus to play a game, the apparatus including a play base (13) and at least a first member (33) located a pre-determined spaced distance apart from the play base (13), the method including the steps of a user moving the at least first member (33, *movement in the form of spinning*)

relative to the play base (13), the movement of or at least the result of the movement of the at least first member (33) relating to one or more pre-determined criteria (*such as indicating a particular color*) for allowing further playing of the game by the user or one or more further users according to a set of rules.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lodrick, Sr. (US Patent No. 4,690,657) in view of Soto, II.

Lodrick, Sr. (US Patent No. 4,690,657) discloses the claimed invention except for the frame being detachably attached to the play base.

Soto, II teaches a frame (14) detachably attached (*via rod 30 within a hole 32*) to a play base (12).

It would have been obvious to one having ordinary skill in the art at the time the invention to provide a frame that is detachably attached to a play base as taught by Soto, II, since such a modification would allow the toy to be stored easily.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lodrick, Sr. (US Patent No. 4,690,657) in view of Lodrick, Sr. (US Patent No. 5,052,968).

Lodrick, Sr. (US Patent No. 4,690,657) discloses the claimed invention except for the magnet of the first member provided with a toy in the form of a cartoon character.

Lodrick, Sr. (US Patent No. 5,052,968) discloses a magnet of a first member (16) provided with a toy in the form of a cartoon character (see Figure 1, for example).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a toy in the form of a cartoon character as taught by Lodrick, Sr. (US Patent No. 5,052,968), since such a modification would make the toy more aesthetically appealing.

Allowable Subject Matter

Claims 7, 8, 18, 19, 22-25, 27-32, and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

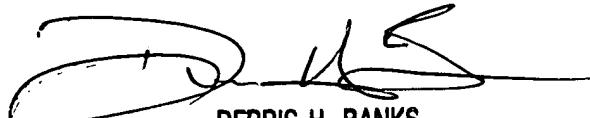
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 571-272-4420. The examiner can normally be reached on Monday through Friday, from 5:45AM - 2:15PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 571-272-4419.

Art Unit: 3714

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for both regular and After Final communications.

Urszula M. Cegielnik
Assistant Examiner
Art Unit 3714



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
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